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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,482	11/09/2001	Jimmy G. Bassett	32887/265439	9777

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EXAMINER

ALLEN, MARIANNE P

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 03/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

2/1

# Office Action Summary

Application No.

10/039,482

Applicant(s)

BASSETT ET AL.

Examiner

Marianne P. Allen

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-121 is/are pending in the application.
- 4a) Of the above claim(s) 4-13 and 23-121 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-121 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/4/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of species II (claims 14-22) in the response submitted 12/15/03 is acknowledged. The traversal is on the ground(s) that there is no burden of search. This is not found persuasive because each of the thirteen species is directed to a different task that would require non-coextensive literature searches. Prior art applicable against one species would not necessarily anticipate nor render obvious any other species.

The requirement is still deemed proper and is therefore made FINAL.

Claims 4-13 and 23-121 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the response submitted 12/15/03.

### ***Claim Rejections - 35 USC § 112***

Claims 1-3 and 14-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This is an enablement rejection.

Claims 14-19 are directed to a system for predicting the standard adhesive properties for a component blend. Claim 1 is a generic system. Claims 20-21 are directed to methods for predicting the standard adhesive properties for a component blend. Claim 2 is a generic method.

Claim 22 is directed to a computer-readable medium for predicting the standard adhesive properties for a component blend. Claim 3 is a generic computer-readable medium.

The specification discloses on pages 21-26 and in Figures 7A-G properties of pressure sensitive adhesive formulations for thirteen specific component blends and for six specific adhesive properties. The specification discloses that a model was developed to predict the six specific adhesive properties based upon the input of a component blend consisting of *Eastotac H-100R* resin, natural rubber, and paraffin oil along with a hindered phenol antioxidant, all dispersed in toluene and containing 0.5% of an antioxidant. This model is not disclosed and one of ordinary skill in the art would not know how to predict standard adhesive properties for component blends having different proportions than those in Figure 7G. Only experimental values are provided and no information on calculations as required by the claims. (See for example, claim 14, line 3.) No guidance for developing predictive algorithms or models is provided.

The specification provides no guidance or disclosure for predicting the standard adhesive properties of other types of adhesives or pressure sensitive adhesives having component blends other than those consisting of *Eastotac H-100R* resin, natural rubber, and paraffin oil along with a hindered phenol antioxidant, all dispersed in toluene and containing 0.5% of an antioxidant. The disclosure also requires that the formulation input total 99.5%. There is no guidance or disclosure for predicting the standard adhesive properties for a component blend where the total is not 99.5% (for example, inputting 5% natural rubber and 3% *Eastotac H-100R* resin).

Note that claims 1-3, 14, 16, 18, 19, 20, and 22 do not specify what the input information is. The specification discloses using the component blend formulation as input. It is unknown

how an input such as “3M Post-It Notes” and no input concerning the component blend formulation could be used to predict the standard adhesive properties.

Note that claims 1-3, 14-15, and 17-22 do not specify what particular standard adhesive properties of the component blend are to be calculated and output. The specification discloses the standard adhesive properties 180-peel strength, PolyKen tack, rolling ball tack, quick stick, room temperature hold power, and shear adhesive failure temperature. The adhesive was coated on Mylar polyester film. It is unknown how a standard adhesive property such as adhesion to a particular substrate (for example, wood or glass) or viscosity would be predicted based on the teachings of the specification.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Moore et al. (U.S. Patent No. 6,304,869).

Moore et al. discloses a relational database management system (including computer-readable medium containing computer-executable instructions, system and method of use) for chemical structure storage, searching, and retrieval. Input, output, and processing modules are disclosed. The data output relates to a chemical product. (See at least abstract, claims, and figures.)

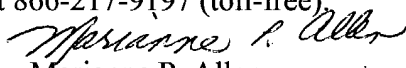
### ***Conclusion***

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen whose telephone number is 571-272-0712. The examiner can normally be reached on Monday-Thursday, 5:30 am - 1:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571-272-0722. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Marianne P. Allen  
Primary Examiner  
Art Unit 1631  
3/23/04

mpa